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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,281	07/06/2001	Robert L. Heston	HO-P01981US1	6089
26271	7590	02/01/2006	EXAMINER	
FULBRIGHT & JAWORSKI, LLP 1301 MCKINNEY SUITE 5100 HOUSTON, TX 77010-3095			MOONEYHAM, JANICE A	
			ART UNIT	PAPER NUMBER
			3629	

DATE MAILED: 02/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/900,281

Applicant(s)

HESTON, ROBERT L.

Examiner

Janice A. Mooneyham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 July 2001 and 22 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 1-25 and 31-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This is in response to the applicant's communications filed on July 6, 2001 and December 22, 2005, wherein claims 26-30 are currently pending in this application.

### ***Election/Restrictions***

2. Claims 1-25 and 31-45 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on December 22, 2005.

Applicant's election with traverse of claims 26-30 in the reply filed on December 22, 2005 is acknowledged. The traversal is on the ground(s) that that the inventions are not independent, that undue searching should not be required and the applicant invites the Examiner to identify another process which is materially different from that set forth in the restricted claims to make the product as claimed. These arguments are not found persuasive. The Examiner believes that the restriction is proper since the subcombinations are distinct from each other and are shown to be separately usable. The restriction was not based on a product and process or making, therefore, the Examiner does not find this argument relevant. Claims 1-25 has separate utility such as facilitating legal services by providing legal services communication avenues between a client and a legal entity, classified in class 705, subclass 500. Claims 26-30 have separate utility such as performing legal services for clients involving receiving an access identifier, displaying case information referenced by the identifier, selecting case information, and displaying specific client case matter information responsive to the

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selection, classified in class 705, subclass 1. Claims 31-35 have separate utility such as performing legal services for clients by drafting, storing and providing legal forms having a data field template for receiving client specific data, classified in class 707, subclass 1. Claims 36-40 have separate utility such as performing legal services for clients over a network by associating a tag identifier with a legal topic, entering information pertaining to the legal topic and storing the information, classified in class 715, subclass 1. Claims 41-45 have separate utility such as performing legal services for clients over a network by creating navigation path records, storing the paths and path records in a database and displaying the path records to a client, classified in class 709, subclass 1.

Examiner notes that it would be a serious burden to search all these inventions given their separate status in the art as noted above.

The requirement is still deemed proper and is therefore made FINAL. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

### ***Claim Rejections - 35 USC § 102***

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 26 and 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Grow (US 6,694,315) (hereinafter referred to as Grow).

Referring to Claim 26:

Grow discloses a computer implemented method for performing legal services for clients over a network, said method comprising the steps of:

receiving an access identifier from a client into a program interface (Figures 2(a) and 2b (210); col. 4, lines 15-21 and 53-61; col. 7, lines 24-32 upon accessing the website 140, the user workstation will be prompted with a presentation requesting a login identification such as a user ID and a password);

authenticating the access identifier (col. 7, line 33- col. 9, line 10 the identification information input at the user workstation 110 in response to the prompt is received at the website 140 and verified; once the user is verified as a registered user, the host computer will display the user information at the workstation);

displaying one or more collections of case information, said case information being referenced by the client identifier (col. 5, lines 23-24 a cross reference or link to the user ID field 210 can also be stored in the case table 230; col. 5, lines 4-22 case table 230; information relevant to a claim acknowledgement document or request of medical records can be stored in the case information field 240, or information relevant to a real estate contract, appraisals, or loan applications);

receiving a selection of one or more collection of case information (col. 8, lines 46-50 the website prompts the user workstation 110 for the case ID); and

responsive to the selection, displaying specific client case matter information (col. 8, lines 46-54 the website 140 first prompts the user workstation 110 for the case ID. In this manner, the host computer 150 can access the case table 230 and determine

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whether case information corresponding to the input case ID was previously stored; if case information is already stored corresponding to the input case ID, the stored case information is displayed at the user workstation 110).

Referring to Claim 30:

Grow discloses wherein the client case matter information includes a schedule of court dates for a case (col. 5, line 61 thru col. 6, line 17 docket field 245 contains a docket or deadline chart; the trigger date field 250 contains a trigger date. For example in a personal injury action, if an Answer must be filed with the court 30 days after service of the Complaint, the date the Complaint is served is the trigger date for filing the Answer).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Grow as applied to claim 26 above, and further in view of Bedell et al (US 6,622,128) (hereinafter referred to as Bedell).

Referring to Claim 27:

Grow discloses the method of claim 26. Grow does not disclose the client case information including billing information.

However, Bedell discloses the client case matter information including client billing information (Figure 3).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate into the case data and docketing method disclosed in Grow the client billing information taught in Bedell so as to provide a means by which legal billing of budgets may be established and monitored in light of on-going billing and to allow users to view and measure incurred fees and expenses while they are accumulating.

Referring to Claim 28:

Bedell discloses wherein the client case matter information includes billing and payment schedules (col. 12, lines 22-25 the system enables interim payments to be made by producing detailed legal bills for completed work products).

Referring to Claim 29:

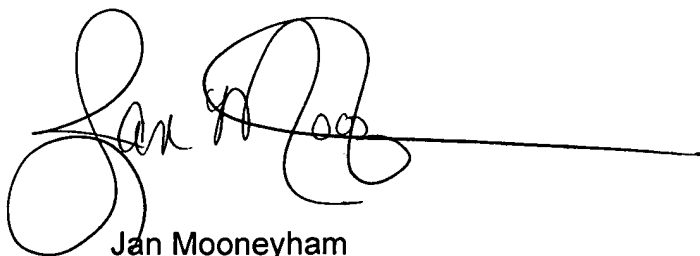
Bedell discloses wherein the client case matter information includes time sheets identifying time worked by a legal entity (Figure 29).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Jan Mooneyham", followed by a long horizontal line extending to the right.

Jan Mooneyham  
Patent Examiner  
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